

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference 105,901 (LG)
Technology Center 1600

LIEPING CHEN,

Application 12/347,492,
Junior Party,

v.

GORDON FREEMAN, VASSILIKI BOUSSIOTIS,
TATYANA CHERNOVA, and NELLY MALENKOVICH

Patent 7,038,013,
Senior Party.

DECLARATION

Before: LORA M. GREEN, *Administrative Patent Judge*.

1 **Part A**

2 **Declaration of Interference**

3 Consistent with discussion during a conference call between counsel
4 for Party Chen and Party Freeman on 06 June 2012 in related interferences
5 105,884; 105,885; and 105,887; an interference is declared between the
6 above-identified parties. 35 U.S.C. § 135(a); 37 C.F.R. § 41.203(b).

7 Details for the application, patent, count and claims designated as
8 corresponding or as not corresponding to the count appear in Parts E and F
9 of this DECLARATION.

10 A claim of an involved application or involved patent which is *not*
11 designated as corresponding to *any* count is not "involved" in the
12 interference within the meaning of 35 U.S.C. § 135(b).

13 For a United States patent or published application listed in this
14 Declaration, see

15 <http://patft.uspto.gov/>

16 See also

17 <http://portal.uspto.gov/external/portal/pair>

18 for prosecution histories available to the public.

19 **Part B**

20 **Judge Managing the Interference**

21 Administrative Patent Judge Lora M. Green has been designated to
22 manage the interference. 37 C.F.R. § 41.104(a).

1 **Part C**

2 **Standing Order**

3 A Trial Division STANDING ORDER (8 March 2011) (Paper 2)
4 accompanies this DECLARATION.

5 The STANDING ORDER applies to this interference, including the
6 provisions related to Electronic Filing. See ¶ 105, pages 15-17

7 **Part D**

8 **Initial Conference Call and Motions Lists**

9 Conference Call

10 In the conference call on 06 June 2012, counsel for Chen and Freeman
11 indicated that the motions would be essentially the same as those filed in the
12 related interferences. Thus, accompanying this Declaration is an order
13 authorizing motions. If the parties feel that additional discussions as to the
14 motions lists are necessary, they can contact the Board to set up a conference
15 call.

16 Time periods for taking action during the motions phase are set out in
17 an order accompanying this Declaration.

Part E

**Identification of the Parties
Assignment of Exhibit Numbers
Initiating Settlement Discussions**

Junior Party

Inventors: LIEPING CHEN

Application: Application 12/347,492
filed 31 December 2008

Pat. Publication US 2009/0274666

Title: B7-H1, A Novel Immunoregulatory Molecule

Real party in interest: Mayo Foundation for Medical Education and
Research

Senior Party

Inventors: GORDON FREEMAN,
VASSILIKI BOUSSIOTIS,
TATYANA CHERNOVA, and
NELLY MALENKOVICH

Patent: U.S. Patent 7,038,013
issued 02 May 2006
based on application 10/002,775
filed 05 December 2001

Pat. Publication US 2002/0102651

Title: B7-4 Polypeptides and uses thereof

Real party in interest: Dana-Farber Cancer Institute, Inc.

Assignment of Exhibit Numbers

Senior party: Exhibit Numbers 1001 through 1999.
Junior party: Exhibit Numbers 2001-2999.
Board: Exhibit Numbers 3001-3999.

Initiating Settlement Discussions

STANDING ORDER ¶ 126 (Paper 2, page 37)

The senior party is responsible for initiating settlement discussions required by the STANDING ORDER.

Part F

Counts and Claims of the Parties

Count 1

An isolated polypeptide comprising the amino acids having the sequence set forth in Chen SEQ ID NO:1 or Freeman SEQ ID NO: 4.

The claims of the parties are:

Chen: 1, 2, 4, 6, 11-13, 36-38, 40-44, 49-59, 62-71, 77, 78, and 80-124.

Freeman: 1-14

The claims that correspond to Count 1 are:

Chen: 6, 38, and 107-114

Freeman: 1-14.

The claims that do not correspond to Count 1 are:

Chen: 1, 2, 4, 11-13, 36, 37, 40-44, 49-59, 62-71, 77, 78, 80-106, and 115-124

Freeman: None

1 With respect to Count 1, the parties are accorded an earlier
2 constructive reduction to practice (i.e., benefit for the purpose of priority) of
3 the following applications:

4 Chen: Application 12/347,492, filed 31 December 2008;
5 Application 09/649,108, filed 28 August 2000;
6 Application 09/451,291, filed 30 November, 1999.

7 Freeman: Application 10/002,775, filed 02 November 2001;
8 Application 09/644,934, filed 23 August 2000;
9 Provisional application 60/150,390,
10 filed 23 August 1999.

Part G

Heading to be Used on Papers

The following heading shall be used on all papers filed in this interference [STANDING ORDER ¶ 106.1.1 (Paper 2, page 17)].

Filed by: [name of party] *Paper leave blank*
[Name of attorney] Date filed: [enter date emailed to Board]
[Email address of attorney]
[Telephone number of attorney]

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Patent 7,038,013,
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Title of Paper, e.g., CHEN SUBSTANTIVE MOTION I

1 **Part H**

2 **Order Form for Requesting File Copies**

3 When requesting file copies, a party shall use STANDING ORDER
4 Form 4 (page 68).

5 Use of form 4 will expedite processing of any request.

6 A party should attach to any request for file copies a photocopy of
7 Part E of this DECLARATION with a hand-drawn circle around the patent
8 and application files for which a copy of a file wrapper is requested.

9 The parties are advised that a single order for file copies may be filled
10 by the Office of Public Records in more than one package. STANDING
11 ORDER ¶ 109.2 (Paper 2, pages 22-24).

12 **Part I**

13 **Required Paragraph of Affidavits and Declarations**

14 The Board has experienced cases in which a witness has belatedly
15 advanced reasons why the witness would be unable to appear for cross
16 examination at a reasonable time and place in the United States.

17 Consequently, to prevent surprise and hardship to the party relying on
18 the testimony of a witness, the following paragraph must be included on the
19 signature page of all affidavits (including declarations) filed in this case.
20 STANDING ORDER ¶ 157.2 (Paper 2, page 49).

21
22 In signing this [affidavit [declaration]], I understand that the
23 [affidavit [declaration]] will be filed as evidence in a contested
24 case before the Board of Patent Appeals and Interferences of
25 the United States Patent and Trademark Office. I acknowledge
26 that I may be subject to cross examination in the case and that
27

1 cross examination will take place within the United States. If
2 cross examination is required of me, I will appear for cross
3 examination within the United States during the time allotted
4 for cross examination.

cc (via electronic mail):

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